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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/596,402	06/16/2000	Oscar Jimenez	P-9399.00	3509

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EXAMINER

BRADFORD, RODERICK D

ART UNIT	PAPER NUMBER
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3762

DATE MAILED: 07/01/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

EE

Office Action Summary	Application No.	Applicant(s)	
	09/596,402	JIMENEZ ET AL.	
	Examiner	Art Unit	
	Roderick Bradford	3762	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 April 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 and 10-25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8 and 10-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
 If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☐ All b) ☐ Some * c) ☐ None of:
 1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
 * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
 a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed April 7, 2003 have been fully considered but they are not persuasive. The arguments are moot in view of new grounds of rejection necessitated by amendment.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 1-8, 10-25 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Referring to claim 1, the original specification does not define or use to describe the shield being "generally planar" nor "the shield being generally perpendicular to an axis". This rejection is related to new matter.

4. Claims 1-8, 10-25 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Referring to claim 1, there is no way of determining what the limits and the scope of "generally planar" and "the shield being generally perpendicular to an axis" are

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suppose to be, since it is not stated in the claim or the specification. This rejection is related to enablement.

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 1-8 and 10-22 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

7. The terms "generally planar" and "generally perpendicular" in claim 1 are relative terms that render the claim indefinite. The terms "generally planar" and "generally perpendicular" are not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

Claim Rejections - 35 USC § 102/103

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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10. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

11. Claims 1-8, 10, 11, 13, 14, 17 and 22 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Kelly et al. U.S. Patent No. 4,041,955.

From figure 2 the examiner considers 33, 35 to be generally planar, 36 is the shield which is generally perpendicular to the axis, lines 35 of the recharging coil 21.

Referring to claim 1, Kelly discloses an implantable medical device comprising:

- Electronics carried in the housing and configured to perform a medical therapy
- A rechargeable power source carried in the housing and coupled to the electronics (Fig 3)
- A secondary recharging coil coupled to the electronics and rechargeable power source (column 7, lines 64-67)
- A magnetic shield placed on the distal side of the receiving coil to improve recharging efficiency (Fig. 2)

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It is inherent that the housing has an electrical feedthrough since it has leads extending through the housing. In the alternative Kelly discloses the claimed invention except for an electric feedthrough. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the invention as taught by Kelly, with an electrical feedthrough since it is well known in the art that implantable devices have electrical feedthroughs for providing energy.

Referring to claim 18, wherein the secondary recharging coil is an external secondary charging coil located away from the housing (Fig 2).

Referring to claim 19, wherein the recharging coil is located in the housing interior cavity (Fig 3).

12. Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kelly et al. U.S. Patent No. 4,041,955 in view of Schulman et al. U.S. Patent No. 6,067,474.

Referring to claim 12, Kelly fails to disclose wherein the magnetic shield includes eddy cuts to reduce eddy current flow through the magnetic shield. However, Schulman includes eddy cuts to reduce eddy current flow through the magnetic shield (Fig. 3A-C) as a means of more accurately and efficiently improve charging.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the teachings of Kelly, as taught by Schulman, to include eddy cuts to reduce eddy current flow through the magnetic shield (Fig. 3A-C) as a means of more accurately and efficiently improve charging.

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13. Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kelly et al. U.S. Patent No. 4,041,955.

Kelly discloses the claimed invention except for wherein the device further comprises a second insulator placed between a second magnetic shield and a third magnetic shield. It would have been an obvious matter of design choice to one skilled in the art to modify the teachings of Kelly, since the applicant has not disclosed that a second insulator placed between a second magnetic shield and a third magnetic shield provides any criticality and/or unexpected results and it appears that the invention would perform equally as well with any insulator placed between a second magnetic shield and a third magnetic shield, such as the insulator and shield as taught by Kelly as a means of protecting the shields..

14. Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kelly et al. U.S. Patent No. 4,041,955.

Kelly discloses the claimed invention except for wherein the first and second insulator are selected from the group consisting of: plastic, mylar, and tape. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the device as taught by Kelly, with a first and second insulator selected from the group consisting of: plastic, mylar, and tape since it is well in the art that plastic, mylar, and tape have very good insulating properties and are used in implantable devices as insulators.

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15. Claims 23-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Zarinetchi et al. U.S. Patent No. 6,234,431 in view of Schulman et al. U.S. Patent No. 6,067,474.

Referring to claim 23, Zarinetchi discloses a medical implantable device comprising:

- A housing having an interior cavity, a proximal face and at least one electrical feed through (22)
- Electronics carried in the housing interior cavity and configured to perform a medical therapy (column 4, lines 47-50 and Fig. 2)
- A rechargeable power source carried in the housing interior cavity and coupled to the electronics (Fig. 5)
- Secondary recharging coil coupled to the electronics and rechargeable power source (column 3, lines 5-14)
- A means for improving recharging efficiency placed on a distal side of the secondary coil (column 7, lines 64-67)

But Zarinetchi fails to disclose the means having eddy cuts to reduce eddy current flow and the means located between the recharging coil and the electronics. However, Schulman discloses eddy cuts to reduce eddy current flow and the means located between the recharging coil and the electronics (Fig. 3A-3C) as a means of more accurately and efficiently improve charging.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the teachings of Kelly, as taught by Schulman, to include

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eddy cuts to reduce eddy current flow through the magnetic shield (Fig. 3A-C) as a means of more accurately and efficiently improve charging.

It is inherent that the housing has an electrical feed through since it has leads extending through the housing. In the alternative Kelly discloses the claimed invention except for an electric feed through. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the invention as taught by Kelly, with an electrical feed through since it is well known in the art that implantable devices have electrical feed through for providing energy.

Conclusion

The Kelly et al. and the Zarinetchi reference cover the majority of the claims inherently and the Kelly et al. reference is capable of performing the functional use recitations presented in the claims.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Roderick Bradford whose telephone number is (703) 305-3287. The examiner can normally be reached on Monday - Friday 7 a.m. - 4 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Angela Sykes can be reached on (703) 308-5181. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9302 for regular communications and (703) 872-9303 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0858.

R. Bradford
R.B. 6/12/03
June 12, 2003

George R. Evanisko
GEORGE R. EVANISKO
PRIMARY EXAMINER

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